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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,496	12/28/2001	Yeh-Hung Lai	81880PAL	8406

7590 11/21/2003

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/033,496	LAI ET AL.	
	Examiner	Art Unit	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's remarks filed on 8/20/2003.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Election/Restrictions

4. Applicant's election with traverse of Group I in Paper filed 8/20/2003 is acknowledged. The traversal is on the ground(s) that "the Examiner has not shown that the cutting device is suitable for non-coating paper. However, even if it were shown that non-coating paper was suitable, the use of non-coating paper would not meet the terms of claims 10-17 because claims 10-17 incorporate the sheet of claims 1-9. Furthermore, under compact examination the inventions should be examined together for effective use of time, as art and the method require overlapping searches. ..."

(Remarks, page 5). This is not found persuasive because Applicant fails to specifically point out the supposed errors in the Examiner's action, which would include stating why the cutting device is not suitable for non-coating paper. Further, regarding Applicant's argument that "claims 10-17 incorporate the sheet of claims 1-9." (Remarks, page 5, 4th paragraph), the Examiner notes that it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular

structure, *Ex parte Pfeiffer*, 1962 C.D. 408 (1961), Applicant's argument to the contrary notwithstanding. Finally, the Examiner repeats (see Paper No. 0626, page 2) that because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

5. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's argument that "The usage of the term "flange" in the present application is consistent with the definition provided by the Examiner" (Remarks, page 7, bottom paragraph) is not persuasive. The Examiner repeats (see Paper No. 0626, page 4) that the term "flange" in claim 1 is used by the claim to mean "skin", "cover" or "outer", while the accepted meaning is "A protruding rim, edge, rib, or collar, as on a wheel or a pipe shaft, used to strengthen an object, hold it in place, or attach it to another object". It should be noted that the sheet structure of the instantly claimed imaging member bears no resemblance of a wheel or pipe shaft. With respect to Applicant's contention that "On page 5 lines 22-25 ... it is stated that the flange layers provide stiffness on either side of the foam core" (Remarks, page 8, top paragraph), the Examiner notes that in such a statement Applicant fails to expressly provide the

structural description of “flange layers”. As such, the Examiner maintains the term “flange” in claim 1 is vague and indefinite, i.e., it is unclear as to the scope of the term “flange”.

Similarly, with respect to Applicant contention that “on page 8 lines 21-26 of the present application it is clearly indicated that “caliper” refers to thickness.” (Remarks, page 8, second paragraph), the Examiner notes that the quoted passage appears to present a fixed core thickness, but nowhere it provides express or inherent support that “flange caliper” means flange thickness. As such, the Examiner maintains the term “caliper” in claim 2 is vague and indefinite, i.e., it is unclear as to the scope of the term “caliper”.

With respect to Applicant’s argument that “Claim 1 discloses that flange layers are adhered to the upper and lower sides of the foam core. Page 5 lines 24-25 also discloses that the flange layers are used to create stiffness on either side of the foam core.” (Remarks, page 8, bottom paragraph), the Examiner notes that Applicant’s statement appears erroneous, since claim 1 clearly does not recite flange layers are adhered to the upper and lower sides of the foam core. As such, in an open termed “comprising” clause, both the “upper and lower” flange layers can be on one side of foam core, and the structural relations of the layers are deemed to be vague and indefinite. Further, it should be noted that although the claims are interpreted in light of the Specification, limitations from the Specification are not read into the claims. See *In re Van Geuns*, 988 f.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Response to Remarks

6. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 10, 12, 18, 19 and 21-23 of U.S. Patent No. 6537656 to Dontula et al., substantially for the reasons set forth in section 10 of Paper No. 0626, together with the following additional observations.

Applicant's response stated that a terminal disclaimer has been submitted (Remarks, page 10, top paragraph), however, the Examiner notes that no disclaimer of record has been received.

7. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 8, 9 and 10-12 of U.S. Patent No. 6447976 to Dontula et al., substantially for the reasons set forth in section 11 of Paper No. 0626, together with the following additional observations.

Applicant's response stated that a terminal disclaimer has been submitted (Remarks, page 10, top paragraph), however, the Examiner notes that no disclaimer of record has been received.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 4309-
1700

Daniel Zinker